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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/809,020

03/24/2004

Dana C. Bookbinder

BOOKBINDER 16-6-1C

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CORNING INCORPORATED
SP-TI-3-1
CORNING, NY 14831

EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/809,020	Applicant(s) BOOKBINDER ET AL.	
	Examiner Margaret G. Moore	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 to 41, 43, 44, 46 to 52 is/are pending in the application.
- 4a) Of the above claim(s) 47, 48 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 to 41, 43, 44, 46, 49, 51 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The Examiner notes that the status identifiers in claims 47 and 48 should include "withdrawn" to indicate that these claims are, in fact, withdrawn from consideration. See MPEP 714 (C.).
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 34 to 41, 43, 44, 46 49, 51 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa et al.

Applicants' amendment has not overcome this rejection. The claims are considered to be anticipated by Ogawa et al. in two different ways.

Initially the Examiner notes tat the protective layer requirement newly added to claim 34 is fully met by the teachings in Ogawa et al. Applicants do not traverse this fact.

Applicants argue that claim 34 requires an intermediate product used in the manufacture of an optical fiber. This is not totally accurate. Claim 34 allows for an article that *can be* used to form an optical fiber preform from which an optical fiber can be drawn. This is a future intended use clause. Patentees need not teach this future intended use and applicants have not shown or even argued that the silica containing article in Ogawa cannot be used to form an optical fiber preform from which an optical fiber can be drawn. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicants have not met their burden in showing that the optical fiber in Ogawa et al. cannot perform the intended use claimed.

On the other hand, note that the Examiner has included claim 46 in this rejection (as well as claims 51 and 52). This new ground of rejection was not necessitated by applicants' amendment and as such this action cannot be made final.

Applicants' claim includes a preform from which an optical fiber can be drawn. Upon further consideration, the Examiner is unable to determine any exact structural limitation for the term "preform". It would appear, for instance, that the optical fiber in Ogawa et al. could be considered a perform since it could be used to draw an optical fiber, for instance a thinner or smaller fiber than that initially used. The Examiner can find nothing that distinguishes the claimed preform from the prior art fiber.

4. Claims 34 to 38, 41, 43, 46 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2-258643.

This rejection is maintained from the previous office action. Applicants' traversal is not persuasive. It is argued that JP 2-258643 does not mention or suggest any of the organic materials required in claim 34 but this is incorrect. As noted in the previous office action, this reference teaches a polyacryl resin layer which meets the claimed polyacrylate. In addition, a layer which includes an organic material which comprises at least one hydrocarbon silane is met by a silicone system.

5. Claims 43 and 44 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Both of these claims depend upon a rejected claim. This cannot be considered further limiting. In addition the various layers found in claim 43 are much broader than those found in amended claim 34..

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
8/4/08